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| 10/537,583 | 12/14/2005 | Katherine Ann Vouden | 35813-703.831 | 4893 |
| 21971 7590 03/02/2009 WILSON SONSINI GOODRICH & ROSATI 650 PAGE MILL ROAD PALO ALTO, CA 94304-1050 | | | | |
| EXAMINER | | | | |
| OGUNBIYI, OLUWATOSIN A | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

ADVISORY ACTION

The amendment filed 2/3/09 in reply to the final rejection has been entered into the record and considered. However, the amendment does not place the application in condition for allowance for the reasons set forth below.

Objections/Rejections Withdrawn

The objection to claim 8 is withdrawn in view of the amendment to the claims.

The rejection of claim 8 and 27-29 and 30-35 rejected under 35 U.S.C. 112, first paragraph is withdrawn in view of the amendment to the claims.

Rejections Maintained

The following rejections are being maintained. Applicants' arguments over the rejections are briefly addressed below.

1) The rejection of claim 1 under 35 U.S.C. 103(a) as being unpatentable over Weinstock et al. US 6,747,137 B1 published Jun. 8, 2004, filed Feb 12, 1999 (cited in previous action) in view of Onishi et al. Antimicrobial Agents and Chemotherapy, Feb 2000, p. 368-377 (cited in previous action) is maintained for reasons made of record in the final office action mailed 12/3/08.

2) The rejection of claims 23-26 under 35 U.S.C. 103(a) as being unpatentable over Weinstock et al. US 6,747,137 B1 published Jun. 8, 2004, filed Feb 12, 1999 (cited in previous action) and Onishi et al. Antimicrobial Agents and Chemotherapy, Feb 2000, p. 368-377 (cited in previous action) as applied to claim 1 further in view of Chen et al (The Journal of Biological Chemistry, 1990, vol. 265, p.16221-16224, cited in IDS) is maintained for reasons made of record in the final office action mailed 12/3/08.

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3) The rejections of claims 8, 27-29 and 30-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weinstock et al. US 6,747,137 B1 published Jun. 8, 2004, filed Feb 12, 1999 (cited in previous action) in view of Georgopapadakou et al. Expert Opin. Investig. Drugs (2002) 11 (8):1117-1125 and Nakayama et al. Infection and Immunity, Dec. 2000, p. 6712-6719 and Onishi et al (Feb. 2000, Antimicrobial Agents and Chemotherapy p. 368-377, cited previously) and Chen et al (The Journal of Biological Chemistry, 1990, vol. 265, p.16221-16224, cited in IDS) is maintained in the final office action mailed 12/3/08.

Applicant argues that Weinstock et al disclosed over 50,000 nucleic acids sequence encompassing 800 pages and one nucleic acid contig 3807 in view of additional references renders the subject matter of instant claims 1 and 8 obvious. Applicants argue that the fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a prima facie case of obviousness and Applicants cite *In re Baird*, 16 F. 3d 380, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994).

All of Applicant's argument set forth in the response is carefully considered but is not persuasive. The facts of *In re Baird* do not apply in this instance. *In re Baird* was drawn to a chemical case in which a prior art reference disclosed a generic diphenol formula without actually disclosing the claimed bisphenol A. The courts found that the disclosure of a generic chemical formula did not render obvious the claimed species. The instant case is different from *In re Baird* because the prior art patent here i.e. Weinstock et al does not disclose a generic nucleic acid formula or protein formula, instead Weinstock et al teaches a *C. albicans* protein that is predicted to be CCA1 absent other evidence to the contrary such as a comparison of their sequences. Note that there is no underlying structure disclosed for the CCA1 of the instantly claimed method. Even though Weinstock teaches all the proteins or nucleic acids derived from *C. albicans*, the fact still remains that Weinstock et al teaches a *C. albicans* protein that is predicted to be CCA1 - this is different from *In re Baird* where only a generic chemical formula was disclosed and the species was not specifically disclosed. Thus, the facts of *In re Baird* cannot be applied to the instant case because here Weinstock does not teach generic

protein formulas but actually teaches a *C. albicans* protein predicted to be CCA1 and the combination of Weinstock and Onishi renders obvious the instant method as claimed in claim 1 as set forth in the previous office actions (5/29/08 and 12/3/08). Furthermore, just because the Weinstock reference does not teach that CCA1 as essential for *C. albicans* does not teach away from the fact that Weinstock teaches a protein predicted to be CCA1. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., CCA1 is essential in *C. albicans* are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, CCA1 being essential to *C. albicans* is an inherent property of CCA1 and it is not a new characteristic conferred on CCA1 by Applicants.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Finally, the instantly method does not sufficiently distinguish the *C. albicans* CCA1 from the predicted CCA1 of *C. albicans* of Weinstock et al and thus absent other evidence, all of the above rejections are maintained.

Status of Claims

Claims 1,8 and 23-35 are rejected.

Claims 14-16 and 18-22 are withdrawn.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLUWATOSIN OGUNBIYI whose telephone number is 571-272-9939. The examiner can normally be reached on M-F 8:30 am- 5 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Mondesi can be reached on 571-272-0956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Oluwatosin Ogunbiyi/
Examiner, Art Unit 1645

/Robert B Mondesi/
Supervisory Patent Examiner,
Art Unit 1645